

Parent of  
10/771, 766

Ex'r's Search Notes

**DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 11, and 30 (in part), drawn to compounds of formula I wherein  $R^1$ ,  $R^2$ ,  $X=Y$ , and A together form a **tetrahydro-imidazo[1,2-a]-pyrimidinyl** ring, classified in class 544, subclasses 281.
- II. Claims 1, 11, and 30 (in part), drawn to compounds of formula I wherein  $R^1$ ,  $R^2$ ,  $X=Y$ , and A together form a **triazacyclopenta[a]indenyl** ring, classified in class 548, subclasses 258, 262.4.
- III. Claims 1, 11, and 30 (in part), drawn to compounds of formula I wherein  $R^1$ ,  $R^2$ ,  $X=Y$ , and A together form a **tetraazacyclopenta( $\alpha$ )indenyl** ring, classified in class 548, subclass 250.
- IV. Claims 1, 11, and 30 (in part), drawn to compounds of formula I wherein  $R^1$ ,  $R^2$ ,  $X=Y$ , and A together form an **imidazo[1,2-a]imidazole**, classified in class 548, subclasses 302.4, 303.1.
- V. Claim 31, drawn to a method of treating various disorders comprising the administration of a pharmaceutical composition comprising a compound of formula I, classified in class 514, subclasses 259.3, 267, 293, 303, and 393.  
Further restriction will be required if this group is elected.
- VI. Claims 32 and 33 (in part), drawn to compounds, and the process of making formula (WHH). Further restriction will be required if this group is elected.

VII. Claims 34-37 (in part), drawn to compounds, and the process of making formula (Z'), classified in various classes and subclasses. Further restriction will be required if this group is elected.

VIII. Claims 1-10 (in part), and 12-29 (in part), drawn to the remaining compounds of formula (I) that do not belong to the above groups, classified in various classes, and subclasses. Further restriction will be required if this group is elected.

2. The inventions of groups I-IV and VI-VIII differ from each other because each group is drawn to a ring system that is distinct and patentable over each other. Essentially, these are seven independent inventions as compounds of one group can be utilized alone, and not in combination of those in other groups. Note, with a variable core as such, the common property is not enough to keep seven groups in the same Markush claim. Furthermore, a prior art that renders obvious one invention would not do so to the others. Thus, restriction for examination purpose as indicated is proper. However, should applicant traverse on the ground that the seven groups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the seven groups to be obvious variant or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the invention unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other inventions.

Inventions Groups I-IV, and VI-VIII vs. the invention of Group V are related as product and method of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the method for using the product as claimed can be practiced with another

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materially different product or (2) the product as claimed can be used in a materially different method of using that product (MPEP § 806.05(h)). In the instant case the method of treating various disorders can be done using other commercially available drugs such as Prozac, Tylenol, Procardia, Clomiphene, etc.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II - VIII, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Shah R. Makujina on 5-9-03 a provisional election was made with traverse to prosecute the invention of Group IV, claims 1, 11, and 30 (in part). Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-10, and 31-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a. In claim 1, the definition of  $R^2$  as  $D'-D''(R^3)(R^4)$  is unclear. When  $D'$  is a bond, it appears that there is a double bond between  $D''$  and Y. However, in the chemical structure of formula (I),  $R^2$  is singly bonded to Y. Thus, it is not clear what is intended.

b. The last proviso in claim 1 does not seem to make sense because  $Z^1$  is never  $CE^2$ .

#### *Claim Objections*

4. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Specification*

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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***Information Disclosure Statement***

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The IDS of 4-12-02 and 7-22-02 have been considered. The cited references seem relevant to the non-elected subject matter only.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every Saturday morning (starting from 4-7-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

***Tamthom N. Truong***  
***Examiner***  
***Art Unit 1624***

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March 22, 2007